

REMARKS

Applicant has reviewed the Office Action mailed October 24, 2002. No claims are being canceled or amended by this Response. Thus, claims 2-11, 13, 25 are pending in the application. Applicant hereby requests further examination and reconsideration of the application in view of the following remarks.

Claim Rejection Under 35 U.S.C. §102

Claims 2-4, 6, 13-14, 17, and 25 were rejected under 35 U.S.C. §102(b) as being anticipated by Clark, Jr. et al., United States Patent 5,785,913. Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Regarding claims 2 and 13, the Patent Office references col. 2, lines 10-65 and col. 4, lines 10-33 of Clark, Jr. et al. for teaching of "magnetic shielding alloy" as claimed in claims 2 and 13. However, none of the referenced portions, nor anywhere else in the submitted reference, teach or suggest this material. Further, nowhere in the submitted reference is there a teaching of shielding. Therefore, it is respectfully submitted that a prima facie showing of anticipation with regards to claims 2 and 13 has not been established, and withdrawal of the rejection is respectfully requested.

Claims 3, 4, 6, 14, and 17 are believed to be allowable based on dependence from an allowable claim.

Regarding claim 25, the Patent Office references FIG. 12A, element 5, col. 2, lines 10-65 of Clark, Jr. et al. for teaching of "carrier material is thermally conductive" as claimed in claim 25. Claim 25 is a dependent claim of independent claim 23. The Clark, JR. et al. reference fails to teach "a carrier material . . . disposed with a plurality of items . . . including magnetic shielding alloy", as claimed in claim 23. Therefore, for the same

reasons stated above with regards to claims 2 and 13, claim 23 is believed to be allowable. Thus, claim 25 is believed to be allowable based on dependence from an allowable claim.

Claim Rejection Under 35 U.S.C. §103

Claims 5 and 15-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark, Jr. et al. (U.S. 5,785,913) in view of Ameen et al. (U.S. 5,591,034). Applicant respectfully traverses this rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Claim 5 depends from independent claim 2 while claims 15-16 depend from independent claim 13. The Clark, Jr. et al. and Ameen et al. references fail to teach an adhesive, "disposed with a plurality of items . . . including magnetic shielding alloy" as claimed in claims 2 and 13. Instead, Clark, Jr. et al. teaches a hardened particle filled polymer with enhanced mechanical, electrical, or thermal characteristics while Ameen teaches a conformable adhesive for thermal conduction. Further, nowhere in the submitted references is there a teaching of shielding. Therefore the references fail to establish *prima facie* obviousness and withdrawal of the rejection is respectfully requested.

Further, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. It is well established that

[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In*

re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)
quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600
(Fed. Cir. 1988).

In the present case, the Patent Office has selected portions from the references to arrive at the present invention. However, none of the references supply the motivation for their combination as proposed. Moreover, no motivation or suggestion for modifying or combining the cited references as suggested is found in the prior art in general. Rather, the references are relied upon for their teaching of selected elements, but the motivation to combine the elements in the combination as set forth by the present application has not been supplied, absent the impermissible use of the present application as a manual or template. Since the references do not teach or suggest the desirability of the modification, and no such motivation is provided in the prior art in general, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

In making the rejection to claim 5, 15, and 16 under 35 U.S.C. §103 the Patent Office first asserts Clark, Jr. et al. for teaching a first surface is included on an integrated circuit and the second surface is included on a heat sink. The Patent Office then correctly states that the Clark, Jr. et al. reference “does not teach an adhesive is used for bonding between the first component surface including an integrated circuit, and the second component surface including on a heat sink.” The Patent Office then cites the Ameen et al. reference as teaching “an adhesive” to cure the defects of the Clark, Jr. et al. reference. The Patent Office states that it would have been obvious to modify Clark, Jr. et al. according to Ameen et al. However, Clark, Jr. et al. teaches a hardened polymer disposed with magnetic particles while Ameen et al. teaches a conformable adhesive. Neither of the references teach or suggest combining the hardened particle filled polymer of Clark et al. with the conformable adhesive of Ameen et al. in order to bond a first surface to a second surface. Therefore, the references fail to establish obviousness and it is requested that the rejection be withdrawn.

Further, even if the references could be combined they would not provide the claimed invention. The hardened polymer of Clark et al. combined with the conformable adhesive of Ameen et al. does not teach or suggest the claimed invention. Rather than the adhesive with electromagnetic capability shielding characteristics of the present invention, the combination of the above references would provide a hardened polymer

with an adhesive strip stuck to it. Thus, the references fail to provide the claimed invention and carry the burden of showing obviousness.

“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P. 2131.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The cited references teach away from the claimed invention. The Clark, Jr. et al and Ameen et al. references fail to teach to an adhesive having electromagnetic capability (EMC) shielding characteristics provided by use of items disposed in the adhesive, as taught by claims 2 and 13 of the present invention. Instead, the Clark, Jr. et al. reference, teaches to a hardened particle filled polymer having increased mechanical, electrical, or thermal characteristics and does not teach to an adhesive with electromagnetic capability (EMC) shielding. The Ameen et al. reference merely teaches to a thermally conductive adhesive and does not teach to an adhesive with electromagnetic capability (EMC) shielding. Therefore, the references would lead a reasonable person away from the claimed invention and fail to carry the burden of a showing of obviousness. Applicant respectfully requests the withdrawal of the obviousness rejection.

Claims 7-11 and 18-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clark, Jr. et al. (U.S. 5,785,913). Applicant respectfully traverses this rejection.

As stated above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Regarding claims 7-11 and 18-24. The Patent Office references Clark, Jr. et al. and asserts that “[a] change in size is generally recognized as being within the level of ordinary skill in the art.” However, the Clark, Jr. et al. reference fails to teach or suggest the limitation directed to providing items with “electromagnetic capability (EMC) shielding” as claimed in claims 7, 10, 11, 18, 21, 22, and 23 of the present invention. Instead, Clark, Jr. et al. teaches to particles within a hardened polymer which increase mechanical, electrical, or thermal surface characteristics. Further, nowhere in the Clark, Jr. et al. reference does it teach or suggest shielding. Therefore, it is respectfully

submitted that a prima facie showing of obviousness with regards to claims 7, 10, 11, 18, 21, 22, and 23 has not been established, and withdrawal of the rejection is respectfully requested.

Claims 8, 9, 19, 20, and 24 are believed to be allowable based on dependence from an allowable claim.

The rejection only contains the Examiner's statement that "it would have been an obvious matter of design choice to modify the dimension of an item of Clark, Jr. et al." Applicant is required to seasonably challenge statements by the Examiner that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Examiner is hereby requested to cite a reference supporting the position that it would have been obvious to utilize items having the claimed dimensions. If the Examiner is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
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